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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,108	03/12/2004	Steven Lawrence Fors	144273IT (MHM 15333US01)	8939
23446 7590 10/31/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER AMADIZ, RODNEY	
			ART UNIT 2629	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/800,108

Applicant(s)

FORS ET AL.

Examiner

Rodney Amadiz

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-17 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-17 and 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 23 is objected to because of the following informalities: Claim 23 depends upon itself. The Examiner will treat the claim as if it depends upon claim 22.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (U.S. Patent 6,498,604—hereinafter “Jensen”) in view of Iwase et al. (JP 0116354—hereinafter “Iwase”).
3. In response to applicant's arguments, the recitation “touch-sensitive monitor” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As to **Claim 1**, Jensen teaches an input device configured for use with a processing unit in communication with the input device (**Fig. 1**), the input device comprising: a main body having a distal operative end (**Reference Number 1**); and a rollerball positioned within a bearing at said distal operative end (**2**), said bearing retaining said rollerball so that said rollerball is capable of rolling within said bearing (**Col. 4, lines 42-50**), and wherein movement of said rollerball is detectable by the processing unit (**Col. 4, lines 54—Col. 5, line 26 and Col. 5, line 60—Col. 6, line 7**). Jensen fails to teach that the main body, rollerball and bearing are formed of an anti-bacterial material or covered with an anti-bacterial coating. Examiner cites **Iwase** to teach an input device formed of an anti-bacterial material (**See Abstract**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use an anti-bacterial agent to coat all external surfaces of an input device, including the main body, rollerball and bearing, as taught by **Iwase** in the input device taught by Jensen in order to prevent infection (**Iwase—Abstract**).

As to **Claim 2**, Jensen teaches the main body further comprising additional buttons (**4**), and wherein pressing of said additional buttons is detectable by the processing unit (**Col. 3, lines 50-52 and Col. 5, lines 39-45**).

As to **Claim 4**, Jensen teaches that the rollerball is configured to click when the input device is pressed against a surface, and wherein the click of said rollerball is detectable by the processing unit (**Col. 5, lines 34-51**).

As to **Claim 5**, Jensen teaches that the main body is shaped like a pen (**See Fig. 1**).

As to **Claim 8**, Jensen teaches that the input device is configured to wirelessly communicate with the processing unit (**Col. 5, line 61—Col. 6, line 7**).

4. Claims 9, 11, 12 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen in view of Natsuyama and Iwase.

As to **Claim 9**, Jensen teaches an input device configured for use with a processing unit in communication with the input device (**Fig. 1 and Col. 5, lines 7-26 and Col. 5, line 61—Col. 6, line 7**), the input device comprising a shaft-like main body having a distal operative end (**Fig. 1, 1**); a rollerball (**2**) assembly located at said distal operative end of said main body (**See Fig. 1**), said rollerball assembly comprising a rollerball retained within a bearing (**Col. 4, lines 42-45**), said rollerball assembly configured to electrically communicate with the processing unit (**Col. 5, lines 7-26 and Col. 5, line 61—Col. 6, line 7**), said bearing retaining said rollerball so that said rollerball is capable of rolling within said bearing (**Col. 4, lines 42-45 and Col. 5, lines 7-21**); and wherein movement of said rollerball is detectable by the processing unit so that a user may input digital data into the monitor through said rollerball assembly (**Col. 5, line 61-Col. 6, line 52**); and a plurality of lateral buttons (**4**) positioned on said main body (**1**), wherein said plurality of lateral buttons are configured to electrically communicate with the processing unit (**Col. 3, lines 50-52**). Although Jensen does mention contacting a substrate with the input device (**Col. 6, lines 33-52**), it is not clear if the substrate is a touch-sensitive monitor. Therefore, the Examiner cites Natsuyama to teach an input device (**Fig. 1, 1**) with a rollerball (**3**) that is in direct contact with a

touch-screen (**100**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the user contact a touch-panel with an input device as taught by Natsuyama in the system taught by Jensen in order to provide a user friendly interactive interface whereby the user may easily see and touch the appropriate places on the monitor.

Jensen also fails to teach the input device having the body formed of anti-bacterial plastic, the rollerball being anti-bacterial and the lateral buttons also being anti-bacterial. Examiner cites Iwase to teach that the input device is covered with an antibacterial coating (**See Abstract**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to cover all external surfaces of the input device, including the body, rollerball and lateral buttons, with an antibacterial coating as taught by Iwase in the input device taught by Jensen in order to prevent infection (**Iwase—Abstract**).

As to **Claim 11**, Jensen teaches that the rollerball is configured to click when the input device is pressed against a surface, and wherein the click of said rollerball is detectable by the processing unit (**Col. 5, lines 34-51**).

As to **Claim 12**, Jensen teaches that the main body is shaped like a pen (**See Fig. 1**).

As to **Claim 22**, Jensen teaches a method of inputting data into a processing unit of a computer (**Col. 5, lines 61—Col. 6, line 7**), wherein the processing unit displays the data on a screen of a monitor in communication with the processing unit (**Col. 6, lines 15-28**), comprising: providing a rollerball at a distal end of an input device (**Fig. 1**,

2); electrically connecting the input device with the processing unit so that the processing unit detects movement of the rollerball (*Col. 5, lines 61—Col. 6, line 28*); detecting movement of the rollerball by the processing unit (*Col. 5, lines 7-26 and Col. 5, lines 61—Col. 6, line 7*); and displaying data on the screen that corresponds to said detecting step when the input device is activated for data input (*Col. 5, lines 34-51 and Col. 6, lines 15-52*). Although Jensen does mention contacting a substrate with the input device (*Col. 6, lines 33-52*), it is not clear if the substrate is a screen. Therefore, the Examiner cites Natsuyama to teach an input device (*Fig. 1, 1*) with a rollerball (3) that is in direct contact with a screen (100). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the user contact the screen with an input device as taught by Natsuyama in the system taught by Jensen in order to provide a user friendly interactive interface whereby the user may easily see and touch the appropriate places on the screen.

Jensen, as modified by Natsuyama, also fails to teach that the input device is anti-bacterial and that the rollerball is anti-bacterial. Examiner cites lwase to teach that the input device is covered with an antibacterial coating (*See Abstract*). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to cover the input device, including the rollerball, with an antibacterial coating as taught by lwase in the input device taught by Jensen, as modified by Natsuyama, in order to prevent infection (*lwase—Abstract*).

As to Claim 23, Jensen, teaches activating the input device for data input by pressing the input device into the screen until the rollerball clicks (*Col. 27-60*).

As to **Claims 24 and 25**, Jensen discloses the implementation of a click function in an input device (Col. 5, lines 39-45). Jensen, as modified by Natsuyama and lwase, however, fails to teach single clicking the rollerball to activate a click and drag function or double clicking the rollerball to activate an electronic writing function. Examiner takes Official Notice that using a click function, whether single or double click, to perform a dragging/writing function is well known in the art, evidence of which may be found in Kennedy, on Page 5; ¶ 45. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate any click function, including dragging functions and electronic writing functions, in the input device taught by Jensen, as modified by Natsuyama and lwase, since these functions are well known and provide additional helpful operations to the user.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen, Natsuyama and lwase as applied to claims 9-12 and 22-25 above, and in further view of Martinez.

As to **Claim 10**, Jensen, as modified by Natsuyama and lwase, fails to teach that the additional buttons are color-coded to denote different functionality. Examiner cites Martinez to teach keys (***Fig. 4, 506, 508 and 510***) that are color coded to denote different functions (***Col. 16, lines 6-28***). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to provide color-coded keys as taught by Martinez in the input device taught by Jensen, as modified by Natsuyama and

Art Unit: 2629

lwase, so that it may be easier for the user to visually recognize the button that he/she is pressing.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen and lwase in view of Martinez et al. (U.S. Patent 7,116,311—hereinafter “Martinez”).

As to **Claim 3**, Jensen, as modified by lwase, fails to teach that the additional buttons are color-coded to denote different functionality. Examiner cites Martinez to teach keys (**Fig. 4, 506, 508 and 510**) that are color coded to denote different functions (**Col. 16, lines 6-28**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to provide color-coded keys as taught by Martinez in the input device taught by Jensen, as modified by lwase, so that it may be easier for the user to visually recognize the button that he/she is pressing.

7. Claims 13-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen in view of lwase and Orner et al. (USPGPUB 2005/0156952—hereinafter “Orner”).

As to Claim 13, the recitation “medical information system” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural

Art Unit: 2629

limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As to **Claim 13**, Jensen teaches a pen-shaped input device (**Fig. 1, 1**), said pen-shaped input device comprising: a main body having a distal operative end (**Fig. 1, 3**); and a rollerball (**Col. 4, lines 42-45**) assembly located at said distal operative end of said main body (**See Fig. 1**), said rollerball (**Col. 4, lines 42-45**) assembly comprising a rollerball (**2**) retained within a bearing, said rollerball assembly in communicate with said processing unit (**Col. 5, lines 7-26 and Col. 5, line 61—Col. 6, line 7**), said bearing retaining said rollerball so that said rollerball is capable of rolling within said bearing (**Col. 4, lines 42-45 and Col. 5, lines 7-21**), and wherein said processing unit detects movement of said rollerball (**Col. 5, line 61-Col. 6, line 52**). Jensen also teaches a workstation having a processing unit (**Col. 5, line 61—Col. 6, line 7**). Jensen, however, fails to teach an electronic white board having a display screen in communication with said workstation. Examiner cites Orner to teach an electronic white board (**Fig. 1B, 112**) having a touch-sensitive display screen (**114**) that is operated through the use of a stylus (**111**), which is in communication with a workstation (**Fig. 1A, 118**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the use of an electronic white board as taught by Orner in the information system taught by Jensen in order to provide an interactive presentation to local and remote audiences (**Orner, Pg. 1, ¶ 2**).

Jensen, as modified by Orner, also fails to teach that the entirety of the pen-shaped input device is formed of an anti-bacterial material or covered with an anti-

bacterial coating. Examiner cites Iwase to teach that the entirety of the input device is covered with an antibacterial coating (**See Abstract**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to cover the input device with an antibacterial coating as taught by Iwase in the input device taught by Jensen, as modified by Orner, in order to prevent infection (**Iwase—Abstract**).

As to **Claim 14**, Jensen as modified by Orner and Iwase, teaches the white board used in a classroom setting and business setting for displaying information to local audiences (**Orner Pg. 1, ¶ 2**). Jensen, as modified by Orner and Iwase, fails to teach said white board displaying patient scheduling information on said display screen. However, the specification shows no apparent benefits for only displaying patient scheduling information. Therefore, displaying patient scheduling information on the display screen is clearly a design choice based on the specific requirement of the claim. Furthermore, it would have been obvious to one of ordinary skill in the art to display any type of information, including that of patient scheduling information, personal information, weather information, etc. in the information system taught by Jensen, Orner and Iwase since any pertinent information would serve the purpose of providing people with the information needed.

As to **Claim 15**, Jensen, as modified by Orner and, teaches said input device (**Jensen—Fig. 1, 1**) is configured to directly contact said display screen (**Orner—Fig. 1A, 114**) in order to input and manipulate data displayed on said display screen (**Orner, Pg. 1, ¶ 2 and Pg. 3, ¶ 37 and 38**).

As to **Claim 16**, Jensen discloses the implementation of a click function in an input device (***Col. 5, lines 39-45***). Jensen, as modified by Orner and Iwase, however fails to teach single clicking the rollerball to activate a click and drag function. Examiner takes Official Notice that using a click function to perform a dragging function is well known in the art, evidence of which may be found in Kennedy, on Page 5; ¶ 45. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate any click function, including click and drag functions, in the input device taught by Jensen, as modified by Orner and Iwase, since dragging functions are well known and provide an additional helpful operation to the user.

As to **Claim 17**, Jensen as modified by Orner teaches said input device configured to electronically write on said display screen (***Orner—Pg. 1, ¶ 2 and Pg. 3, ¶'s 37 and 38***) so that said processing unit detects movement of said rollerball (***Jensen—Col. 5, line 61-Col. 6, line 52***) and displays corresponding information on said display screen (***Orner—Pg. 1, ¶ 2***).

As to **Claim 21**, Jensen teaches a plurality of lateral buttons (***Fig. 1, 4***) positioned on said main body (***3***), wherein said plurality of lateral buttons are configured to electrically communicate with the processing unit (***Col. 5, lines 38-51***). Jensen, as modified by Orner, however, fails to teach the buttons to be anti-bacterial. Examiner cites ***Iwase*** to teach an outer surface of an input device formed of an anti-bacterial material (***See Abstract***). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use an anti-bacterial material on all external surfaces of an input device, including the buttons, as taught by Iwase in the

Art Unit: 2629

input device taught by Jensen, as modified by Orner, in order to prevent infection

(Iwase—Abstract).

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen Iwase and Orner, as applied to claims 13-17 and 21 above, and further in view of Walker et al. (USPGPUB 2002/0046071—hereinafter “Walker”).

As to **Claim 19**, Jensen, as modified by Iwase and Orner, fails to teach a central database in communication with said workstation. Examiner cites Walker to teach a central database (**Fig. 6, 42a and zone 15 and ¶ 171**) in communication with said workstation (**Fig. 6, 23 and 43**). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate a central database as taught by Walker in the system taught by Jensen, Iwase and Orner in order to provide for uniformity of data making it easier to search through the data.

9. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen, Iwase and Orner, as applied to claims 13-17 and 21 above, and in further view of Natsuyama.

As to **Claim 20**, Jensen teaches said workstation further comprises a monitor having a monitor screen in communication with said processing unit (**Col. 6, lines 21-28**). Jensen also teaches inputting and manipulating data displayed on said monitor screen (**Col. 6, lines 21-28**) Jensen, as modified by Iwase and Orner, however, fails to teach said input device is configured to directly contact said monitor screen. Although

Jensen does mention contacting a substrate with the input device (*Col. 6, lines 33-52*), it is not clear if the substrate is a touch-sensitive monitor. Therefore, the Examiner cites Natsuyama to teach an input device (*Fig. 1, 1*) with a rollerball (*3*) that is in direct contact with a touch-screen (*100*). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the user contact a touch-panel with an input device as taught by Natsuyama in the system taught by Jensen, Iwase and Orner, in order to provide a user friendly interactive interface whereby the user may easily see and touch the appropriate places on the monitor.

Response to Arguments

10. Applicant's arguments filed August 14, 2007 have been fully considered but they are not persuasive. The Applicant argues that "The cover sheet of Iwase does not indicate that the ink delivery tube and tip of the pen are not made up of antibacterial agents. Indeed, the Applicants respectfully submit that a ball point ink delivery system or other such system would not be formed of an anti-bacterial agent. For example, if an ink ball point was covered with an anti-bacterial coating, ink that flowed around the ball point would most likely erode such coating." (Pg. 9). With respect to this argument, the Examiner used Iwase to teach that the concept of applying an antibacterial agent on a pen-type device is well known in the art. Furthermore, Iwase teaches that every surface of the pen device, except for the ink related surfaces, are covered by the antibacterial agent. In addition, the Examiner points out that Jensen is an input device that does not expel ink. Therefore, the Examiner has used the teachings of Iwase, that is, applying

an antibacterial agent to pen-type surfaces that do not expel ink, to modify the input device taught by Jensen. By this reasoning all surfaces of the input device taught by Jensen, including the main body, rollerball and bearing, are covered by the antibacterial agent. As to claim 9, because the lateral buttons are positioned on the main body, the same reasoning also applies in this situation; hence the lateral buttons will also be antibacterial.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Inquiries


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney Amadiz whose telephone number is (571) 272-7762. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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